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EXAMINER

BUCZINSKI, STEPHEN C

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 34

Application Number: 09/506,288
Filing Date: February 17, 2000
Appellant(s): PARK, JIN-SU

MAILED

APR 07 2003

Robert E. Bushnell
For Appellant

GROUP 3600

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 March 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

The brief contains a statement that does not identify any related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. However, the rejection has now been reduced to just claim 20, while all other claims 1-19 and 21-59 are allowable as explained below.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct. However, the rejection has now been reduced to just claim 20 and the issue of a provisional double patenting rejection has arisen based on the statement on page 3 of the Brief that allowed claims in this application that are still pending have been refiled verbatim in new patent application Serial No. 10/337,364.

(7) *Grouping of Claims*

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Appellant's brief includes a statement that claims 20 and 44-58 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct, except as noted above that only claim 20 is now being rejected.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 20 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

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An essential reason argued for the allowability of the original claim 8 (patent claim 7) as presented by Applicant was first introduced in the amendment filed 21 October 1993 (page 4, last paragraph of the remarks of the amendment) in the parent file and presented as well on page 6 of the arguments in the Brief before the Board of Appeals. The Board further limited the above arguments in page 6 of their Decision for allowability to just essentially "*checking for a key-data input signal from said keyboard or remote control during a system power standby mode*", since the reference to Bonneau, then applied against claim 8 was judged by the Board, "*discloses no equivalent requirement for starting the locking process from a system-power-off state. Thus Bonneau does not anticipate the claimed invention.*" The arguments and limitations presented then must at least now be relied upon to define why the present claim 20 of related scope would also be considered allowable over the same art.

Of the original patent application's method claims 2, 8, and 9 (patent claims 1, 7, and 9), present claim 20 on appeal is only related in scope to like process/method claim 8 (patent claim 7) and therefore requires the reason argued for allowability and further limited by the Board of Appeals in the prosecution history as discussed above. Since any method claim is required in reissue proceedings under 35 USC 251 to only correct errors in the parent patent method claims, the scope of the method being claimed is still fairly characterized as being to like-methods within the meaning of the test for recapture under *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d @1600 (Fed. Cir. 2001). The application of the test for determining "*whether and in what aspect the reissue claims are broader than the patent claims*" was an integral function of the analysis by the

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oversight examination conducted in this matter within the examination corps of the PTO, but which is not documented in the record nor is it required to be. However, the results from conclusions drawn after the three-step process are of record as required and repeated below after finding a feature by which this claim has been broadened that was argued as being critical in the prosecution history. Not all features of the original claims were so argued, just that listed below as it relates to the method claims of the same reasonable scope. It should also be noted that step three of the *Pannu* test has been further limited by *Hester Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir.1998), where the Court observed that surrender of claimed subject matter may occur by arguments made during the prosecution of the original patent application even where there was no claim change made.

The present rejected claims do not include "*checking for a key-data input signal from said keyboard or remote control during a system power standby mode*" as required by arguments introduced by Applicant and further supported in the Opinion of the Board of Appeals (mailed 22 July 1997, page 6, lines 10-14 of the Opinion).

(11) Response to Argument

The primary legal precedent for the issues found in this appeal are found in *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) where the Court observed that surrender of claimed subject matter may occur by arguments made during the prosecution of the original patent application even where there was no claim change made. The Court in *Hester* held that the surrender which

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forms the basis for impermissible recapture "can occur through arguments alone" at 1649.

In response to the first of the numbered arguments **I.A-I.C.** in the Brief, it is clear that 35 USC 251 may allow broadened claims where critical features are not left out of the claims on reissue. Critical features are those that are argued as critical in the prosecution history and still enable the claims to meet the requirements under 35 USC 112.

The essential reasons argued for the allowability of the original claim 8 (patent claim 7) as presented by Applicant was first introduced in the amendment filed 21 October 1993 in the parent file and in the arguments presented before the Board of Appeals in the appeal of that one claim. The arguments limited further by the Board in their Decision must now be relied upon to define why the present claim 20 would also be considered allowable over the same art. It is disingenuous to argue that because the claims are now broadened that they are no longer of the same scope. The few critical elements under *Hester* argued by Applicant as essential to the method claims in the prosecution history is:

- *"checking for a key-data input signal from said keyboard or remote control during a system power standby mode"* as deemed critical by arguments first introduced by Applicant on page 8, lines 4-8 in their Brief, but restricted to only the above language in the Opinion of the Board of Appeals mailed 22 July 1997 (page 6).

In the arguments presented under the heading in the Brief as **II.D., F., & G.**, it is clear that without consideration of *Hester* Appellant's arguments would be convincing, but that is not the law. Claim 20 is related in scope to like process/method claim 7 in the parent patent which requires the reasons stated in the prosecution history as discussed above for its allowability. Since reissue method claims are required under 35 USC 251 to only correct errors in the parent patent method claims, the scope of the claims is still fairly characterized as being to like-methods within the meaning of the test for recapture under *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d @1600 (Fed. Cir. 2001). The application of the test for determining "*whether and in what aspect the reissue claims are broader than the patent claims*" was an integral function of the analysis by the oversight examination conducted in reissue applications before the PTO, but which is not documented nor "mandatory" to be documented in the record. The result of the three-step process are of record and is mandatory. Not all features of the original claims were so argued, just that listed below as it relates to a method claim of the same reasonable scope. It should also be noted that step three of the *Pannu* test has been further limited by *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir.1998), where the Court observed that surrender of claimed subject matter may occur by arguments made during the prosecution of the original patent application even where there was no claim change made. It is noted that the changes made to claim 8 in the parent application were essentially typographical.

As to arguments presented under **II.E.** of the Brief, it again falls upon the precedent before us in *Hester*, that Appellant's demonstration of some failure in the

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prior art does indeed become a recapture estoppel that restricts the scope of reissue coverage to claims that recite what was lacking in the prior art. Appellant's example to Patent No. 001 to Hopkins is actually a different argument than that before this office. In the hypothetical reference to Hopkins, Appellant is effectively arguing that the scope and content of the prior art in step one of the test set out *Graham v. John Deere* for obviousness has not been satisfied or is not reasonable by contrast. That was never the point of the arguments before the PTO against the references to Bonneau '623 or Amano '229 which are related to on-screen display and/or tv lock-out features.

As to the arguments presented under **II.H.** of the Brief, broader claims have been shown to be possible where limiting arguments are not present to restrict the elimination of certain limitations in a reissue, while still meeting the requirements of 35 USC 112. Claims 44-58 are method claims that can serve as examples of broadening that meet the requirements where features which were argued in the amendment of 21 October 1993 for the allowability of claims 2-7 and 9 (patent claims 1-6 and 8) are indeed included in these claims. One of those features to audio muting in prior rejections was mistakenly believed to be required in claims 44-58 along with character generation and mixing, but was determined in this examiner's answer preparation to not be necessary, since allowed method claim 1 did not have audio muting and must thereby serve as a basis for the broadest claim of similar scope. The features of character generation and mixing do otherwise appear in claims 44-58. Accordingly, the rejection of claims 44-58 has been withdrawn.

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As to the arguments presented under II.I of the Brief, the arguments in this case actually broaden the possibilities in these reissue claims, because as pointed out above, Appellants restrictive limitations first introduced by Appellant on page 8, lines 4-8 in their Brief, were restricted to the lesser limitations in the Opinion of the Board of Appeals mailed 22 July 1997 (page 6, lines 10-14 of the Opinion). Those limitations or their equivalent are required now for the allowability of claim 20.

As to the arguments presented under II.J & K., no distinguishable arguments can be discerned that have not already been addressed above. It is not within the authority of the examiner to comment or give reasons why the current case law has become the rule. There are no options except by appeal on the merits as adequately presented above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



STEPHEN C. BUCZINSKI
PRIMARY EXAMINER

Stephen C. Buczinski
April 2, 2003

Conferees
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